

REMARKS

The Specification has been amended. Claims 1 - 2, 8, 16 - 17, 20 - 21, 24, and 31 - 39 have been amended. No new matter has been introduced with these amendments, all of which are supported in the specification as originally filed. Claims 1 - 40 remain in the application.

Applicant is not conceding that the subject matter encompassed by the claims as presented prior to this Amendment is not patentable over the art cited by the Examiner, as claim amendments in the present application are directed toward facilitating expeditious prosecution of the application and allowance of the currently-presented claims at an early date. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by the claims as presented prior to this Amendment and additional claims, in one or more continuing applications.

I. Objection to the Specification

Paragraph 1 of the Office Action dated June 14, 2007 (hereinafter, "the Office Action") states that the Specification is objected to, referencing Claim 31. Claim 31 has been amended herein, and the Examiner is respectfully requested to withdraw this objection.

II. Rejection under 35 U. S. C. §101

Paragraphs 3 - 5 of the Office Action state that Claims 20 - 30 are rejected under 35 U. S. C. §101 as being directed to non-statutory subject matter.

In paragraph 4, second sentence, the Office Action states “The IM client is disclosed as the actual software user interface for the IM system on page 9 of the applicant’s specification.” (emphasis added). Applicant respectfully disagrees with this statement, and notes that p. 9 (see para. [0033], first sentence) of his specification states that GUI display 100 “represents an IM client display ...” (emphasis added), not an IM client.

Independent Claim 20 has been amended herein, and Applicant respectfully submits that Claim 20 is directed to statutory subject matter as currently presented. Accordingly, the Examiner is respectfully requested to withdraw the §101 rejection of Claim 20 and its dependent Claims 21 - 30.

III. Rejection under 35 U. S. C. §102(e)

Paragraph 7 of the Office Action states that Claims 1 - 3, 8 - 15, 17, 19 - 21, 24 - 32, and 35 - 40 are rejected under 35 U.S.C. §102(e) as being anticipated by U. S. Patent 7,096,255 to Malik. This rejection is respectfully traversed.

Referring first to Applicant’s independent Claim 1, this claim as currently presented recites:

A method of managing user information in an instant messaging (“IM”) system, comprising steps of:
determining, for an IM client that is operably connected to the IM system, whether any of a plurality of users remembered by the IM client should be treated as expired; and
for each one of the plurality of users for whom the determining step determines that the user is to be treated as expired, omitting this user when

performing selected IM management functions of the IM system by automatically remembering that this user is to be treated as expired but not deleting this user from the plurality of users remembered by the IM client. (emphasis added).

Applicant respectfully submits that Malik fails to teach (at least) the above-underlined recitations of independent Claim 1, as will now be discussed.

Paragraph 8 of the Office Action cites col. 8, lines 23 - 40 of Malik as teaching the “omitting” element of Claim 1. Applicants respectfully submit that Malik does not teach “... omitting this user ... by automatically remembering that this user is to be treated as expired but not deleting this user from the plurality of users remembered by the IM client” (Claim 1, lines 5 - 9). Instead, col. 8, lines 23 - 40 of Malik discuss removing temporary contacts who have expired. See, for example:

- col. 8, lines 23 - 24, “... the temporary contact **300** can be removed ...” (emphasis added);
- col. 8, lines 29 - 32, “If any of the temporary contacts **300, 320** have expired, the service manager **230** can send a request ... to remove the expired temporary contact.” (emphasis added);
- col. 8, lines 35 - 38, “Then when an [sic] temporary contact **300, 320** expires the server can automatically remove the temporary contact ...” (emphasis added); and
- col. 8, lines 38 - 40, “Thus, the next time the user logs in ... the resource list **305** ... will not include the [now-removed] temporary contact **300, 320**.” (emphasis added)

added).

Accordingly, Applicant respectfully submits that a *prima facie* case of anticipation has not been made out as to independent Claim 1 as currently presented. Independent Claims 20 and 31 specify limitations analogous to those of Claim 1. Without more, independent Claims 1, 20, and 31 are deemed patentable over Malik, as are their dependent Claims 2 - 15, 21 - 30, and 32 - 40.

Referring next to independent Claim 17, this claim as currently presented recites:

A method of managing user information in an instant messaging (“IM”) system, comprising steps of:

determining, for an IM client that is operably connected to the IM system, whether any of a plurality of users remembered by the IM client should be treated as expired but not deleted from the plurality of remembered users; and

for each one of the plurality of users for whom the determining step determines that the user is to be treated as expired, providing a different visual representation for this user, as contrasted to the remembered users who are not to be treated as expired, when displaying an IM client display comprising the remembered users to a user of the IM client. (emphasis added).

Applicant respectfully submits that Malik fails to teach (at least) the above-underlined recitations of independent Claim 17, as will now be discussed.

Paragraph 18 of the Office Action cites col. 8, lines 41 - 57 of Malik as teaching the “providing” element of Claim 17, stating “the prompt is considered a different visual representation”. Applicant has clarified his claim language to more clearly specify that the “different visual representation” is provided “when displaying an IM client display comprising

the remembered users” (Claim 17, lines 6 - 10, emphasis added). The cited text from Malik discusses a prompt that is displayed “upon the expiration of a temporary contact” (col. 8, lines 42 - 43) and can “afford the user the opportunity” to take various actions with regard to the expired temporary contact (col. 8, lines 44 - 47).

Accordingly, Applicant respectfully submits that a *prima facie* case of anticipation has not been made out as to independent Claim 17 as currently presented. Without more, independent Claim 17 is deemed patentable over Malik, as are its dependent Claims 18 - 19.

The Examiner is therefore respectfully requested to withdraw the §102 rejections.

IV. Rejections under 35 U. S. C. §103(a)

Paragraph 26 of the Office Action states that Claims 4 - 7, 22 - 23, and 33 - 34 are rejected under 35 U.S.C. §103(a) as being unpatentable over Malik in view of U. S. Patent Publication 2003/0065721 to Roskind. Paragraph 31 of the Office Action states that Claim 16 is rejected under 35 U.S.C. §103(a) as being unpatentable over Malik in view of U. S. Patent Publication 2003/0110044 to Nix et al. Paragraph 33 of the Office Action states that Claim 18 is rejected under 35 U.S.C. §103(a) as being unpatentable over Malik in view of U. S. Patent Publication 2005/0044143 to Zimmerman et al. Paragraph 35 of the Office Action states that Claim 18 is rejected under 35 U.S.C. §103(a) as being unpatentable over Malik in view of U. S. Patent Publication 2004/0172455 to Green et al. Paragraph 37 of the Office Action states that Claim 18 is rejected under 35 U.S.C. §103(a) as being unpatentable over Malik (apparently in

view of the Examiner's Official Notice). These rejections are respectfully traversed.

Referring first to dependent Claims 4 - 7, 18, 22 - 23, and 33 - 34, Applicant respectfully submits that these claims are deemed patentable by virtue of (*inter alia*) the patentability of independent Claims 1, 17, 20, and 31 from which they depend (the patentability of which has been discussed above).

Referring next to independent Claim 16, this claim as currently presented recites:

A method of managing user information in an instant messaging ("IM") system, comprising steps of:
evaluating, for an IM client that is operably connected to the IM system, which of a plurality of users remembered by the IM client should be treated as expired but not deleted from the plurality of remembered users;
providing, for the IM client, a visual indication for the remembered users, in which each one of the plurality of users for whom the evaluating step determines that the user is to be treated as expired is visually indicated differently from ones of the plurality of remembered users that are not to be treated as expired; and
charging a fee for carrying out the evaluating and providing steps.
(emphasis added).

Applicants find no teaching, or any suggestion, in Malik and/or Nix of (at least) the above-underlined limitations of independent Claim 16, as will now be discussed.

Paragraph 32 of the Office Action cites col. 8, lines 41 - 57 of Malik as teaching the "providing" element of independent Claim 16. Refer to the discussion, above, of independent Claim 17, where it has been demonstrated that the "prompt" of Malik pertains to "expiration of a temporary contact" (see, for example, col. 8, lines 42 - 43 and lines 44 - 47). Applicant

respectfully submits that this prompt is distinct from “a visual indication for the remembered users ...” (Claim 16, lines 6 - 7, emphasis added).

In view of the above, Applicants respectfully submit that independent Claim 16 is patentable over Malik and/or Nix (assuming, *arguendo*, that such combination could be made and that one of ordinary skill in the art would be motivated to attempt it).

The Examiner is therefore respectfully requested to withdraw the §103 rejections.

V. Conclusion

Applicant respectfully requests reconsideration of the pending rejected claims, withdrawal of all presently outstanding objections and rejections, and allowance of all claims at an early date.

Respectfully submitted,

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